

RE MARKS

Claims 1, 7-9, 11, 12, 17-19 and 23-35 remain in the application.

Claims 26-35 are allowed (paragraph 4 on page 5 of the Office Action).

The claims remaining for consideration are claims 1, 7-9, 11, 12, 17-19 and 23-25. These claims were objected to because of the use of "ENT," and that has been changed to "electrical nonmetallic." These claims also were rejected under 35 U.S.C. § 103(a) on U.S. Patent No. 5,356,181 to Shirogane et al (hereinafter "Shirogane").

This application relates to fittings for attaching electrical nonmetallic tubing to concrete forms prior to pouring of concrete which covers both the fittings and the tubing. After the concrete has cured, the forms are removed so that the tubing is exposed within a cavity occupied by the fitting. If the installer failed to push the tubing firmly into the socket in the fitting and against the surface of the concrete form, the fitting can be removed to expose a greater length of the tubing for making a connection. The fitting also can be removed if it comes part way out during removal of the forms. If the fitting remains in place and the exposed end portion is long enough, a connector can be attached while leaving the fitting in place. Wires and/or cables then can be extended through the tubing for providing electrical and/or communication services.

The clasp member 3 of Shirogane has openings 12a in FIGS. 1 and 10 that would permit poured concrete to enter the interior of the clasp member if it were to be used in poured concrete construction. The Shirogane clasp member 3 is designed and intended for use with a joint body 2 having projections 7e that extend through openings 12a in the clasp member 3.

The Examiner takes "Official Notice" that it would be obvious to persons of ordinary skill in the art to provide an outwardly extending flange on the Shirogane clasp member 3.

Applicants do not agree with the Examiner's contention. A claim rejection must be based on a clear teaching, suggestion or motivation that provides the person of ordinary skill in the art with a reason for making the modification. There is no teaching, suggestion or motivation that shows a desirability for adding a flange to the Shirogane clasp member 3. Any suggestion of doing so is based on pure hindsight after a reading and understanding of applicant's own specification.

Shirogane has an externally threaded end portion 5 on the body member 2 for reception through a hole in a box. An octagonal portion 6 would bear against an outer surface of the box. Why would a person of ordinary skill in the art provide a flange on the Shirogane clasp member 3? What would the flange be used for? Where is the prior art that provides a teaching, suggestion or motivation to add a flange to the clasp member?

The idea that the Shirogane openings 12a could be eliminated and a flange added for attaching the clasp member to a concrete form is taught only by the present application and not by the prior art. The fitting of the present application provides an advantageous way for workers to attach tubing to a concrete form in a manner not previously known. The Shirogane clasp member 3 cannot be used for that purpose, and the art does not suggest modifying the clasp member to make it useable for applicant's purpose.

All of independent claims 7, 12 and 19 recite the attachment flange that Shirogane lacks. These claims also recite the peripheral wall and endwall of the fitting as being continuous and free of openings through which concrete could enter the fitting. It is plain that Shirogane lacks these features and the prior art provides no teaching, suggestion or motivation to provide Shirogane with such features.

The Examiner's contention that other claimed features are disclosed by Shirogane or are obvious is not well taken. Claims 7 and 12 recite the fitting peripheral wall as being

frustoconical. This provides a larger cavity at the exposed surface of the concrete so that a connector and be attached to the end portion of the electrical nonmetallic tubing within the cavity. The clasp member 3 of Shirogane is used with the body member 2, and there is no reason why a person of skill on the art would make the Shirogane clasp member frustoconical. The Shirogane clasp member 3 desirably slides on the body member 2 with a close fit and a frustoconical shape would not be advantageous.

Claim 8 recites the socket axis as intersecting the plane of the flange outer surface at a 45° angle, and claim 19 recites the socket axis as intersecting such plane at an angle of less than 90°. There is no reason whatsoever for a person of ordinary skill in the art to make the Shirogane clasp member with these relationships.

Claim 12 also recites the fingers as having inner surfaces that lie on the surface of a cone. The fingers in Shirogane are shown as extending parallel to the longitudinal axis of the clasp member 3. There is no reason why a person of ordinary skill in the art would incline the Shirogane fingers inwardly toward the longitudinal axis of the clasp member so that the finger inner surfaces would lie on the surface of a cone.

Claim 19 also recites the bottom opening as having a larger area than the area of the endwall. In Shirogane, the bottom opening has an area that is smaller than the area of the endwall. There is no reason why a person of ordinary skill in the art would make the bottom opening in Shirogane larger than the endwall.

Claim 23 recites the bottom opening as being non-circular, and there is no teaching, suggestion or motivation for a person of ordinary skill in the art to make the opening in the Shirogane clasp member 3 non-circular.

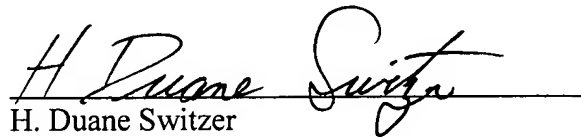
Appln. No. 10/729,739
Amdt. dated August 2, 2006
Reply to Office Action of May 2, 2006

Claims 9, 17 and 24 recite the V-shaped spaces between fingers so that the fingers decrease in circumferential width in a direction from the socket entrance opening toward the finger ends. It is clear that the spaces between fingers in Shirogane are rectangular and the circumferential width of the fingers does not decrease as claimed.

Claims 11, 18 and 25 recite only two opposed fingers as having teeth. All of the fingers in Shirogane include teeth. The claimed arrangement makes it easier to insert the tubing into the socket to better insure that full insertion will occur. The teeth also provide a firmer hold on the tubing while facilitating removal of the tubing from the socket if and when that is desirable.

In the absence of more pertinent art, this application is now in condition for allowance.

Respectfully submitted,

A handwritten signature in cursive script, reading "H. Duane Switzer", is written over a horizontal line.

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